

### **REMARKS/ARGUMENTS**

The Office Action dated April 14, 2008 and the references cited therein have been carefully considered. In response to the Office Action, Applicant has amended Claims 1-5 which, when considered with the remarks set forth below, are deemed to place the case with Claims 1-11 in condition for allowance.

In the Office Action, Claims 1-3, 6 and 11 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,993,374 to Schudy et al. Claims 1 and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,979,626 to Pitts in view of Schudy. Claims 4 and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schudy in view of U.S. Patent No. 5,895,164 to Wu, and Claims 8, 9 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schudy in view of U.S. Patent No. D527,051 to Moy.

#### **Amended Claim 1**

In response, Applicant has amended Claim 1 to define a storage device including suspension elements that urge binder rings between opened and closed conditions upon movement of the suspension elements between a first condition, wherein the suspension elements are contained within the storage device, and a second condition, wherein the suspension elements extend outside the storage device. It is respectfully submitted that none of the cited references, taken alone or combined, disclose a suspension element performing the dual function of suspending the storage device and operating the binder rings, as defined in amended Claim 1.

Instead, the Schudy patent relates to a ring binder device having slide-mounted suspender members which can be set to suspend the device between two carrier rails. As explained in Schudy and shown in FIGS. 1 and 2 of that reference, when the slide member 12 is in a pulled-out position, opening of the ring binder is prevented and the device can be suspended. When the slide member 12 is in a pushed-in position, a locking tongue of the device releases a wire coil that allows for opening and closing of the binder. Thus, while the disclosed slide member may prevent operation of the binder rings, there is absolutely no teaching or suggestion in the Schudy

patent of the slide member actually urging the binder rings opened and closed, as defined in amended Claim 1.

The suspending elements disclosed in the Schudy patent are separate from the means for opening or closing the rings (which apparently have to be pulled open by hand, against the closing spring force). In the present invention, as defined in amended Claim 1, the suspending means performs the dual function in operating the rings and in suspending the binder, wherein the rings can be locked both in the "suspension" position and in a position folded into the binder. In this manner, the rings can be held closed in the two positions in which the binder can be closed, whereas they can only be opened once the binder itself is opened.

Turning to the Pitts patent, this reference relates to a convertible hanging file folder including a suspension means that can be rotated into and out of the binder. The Examiner notes that the Pitts patent does not disclose a suspension element moveable between a first and second condition in which the storage device is in a closed position. It is also readily apparent in the Pitts patent that the disclosed suspension elements have no impact whatsoever on the opening, closing or locking of the rings.

Similarly, none of the other cited references discloses a suspension element performing the dual function of suspending the storage device and operating the binder rings, as defined in amended Claim 1. Accordingly, it is respectfully submitted that amended independent Claim 1, and the claims that depend therefrom, patentably distinguish over the prior art.

#### Amended Claim 4

Claim 4 has also been amended to clarify that the third position of the suspension elements, wherein the binder rings are in an opened position, is disposed between the first and second positions of the suspension elements. Therefore, the suspension elements move from a first position, wherein the suspension elements are contained within the storage device and the binder rings are closed, to a third position, wherein the binder rings are urged open by the suspension elements, to a second position, wherein the suspension elements extend out of the storage device and the binder rings are again urged closed by the suspension elements. It is

respectfully submitted that none of the cited references, taken alone or combined, disclose a suspension element that opens and closes a binder ring as it moves between three positions, as defined in amended Claim 4.

The Examiner cites the Wu patent as disclosing a binder actuating mechanism that moves between three positions. However, putting aside for the moment that the Wu patent is silent as to suspension elements, Applicants also respectfully point out that the positions of the actuating mechanism disclosed in the Wu patent are quite different than the positions of Claim 4. In this regard, the Examiner states that FIG. 6 shows the actuation system slid out to its furthest extreme where the rings are closed (Office Action, Page 6, lines 10-11), when in fact the description of FIG. 6 states that the pull plate is pulled in along an axial direction to an end. FIG. 5 of the Wu reference shows that when the pull plate is pulled outwardly the binding elements are forced open (Wu, col. 3, lines 6-28).

Moreover, the Wu patent only discloses a binder mechanism in which a slide out member is used for opening and closing the rings. The binder mechanism is only present at one end and can therefore not be used as a suspension means. Also, this patent does not disclose a locking means according to the claimed invention. The rings of the Wu device can still be opened if the cover is closed, because the pull tab could be engaged through the side of the binder (for example by movement into or out of a bag) thus releasing the papers from the binder. In the present invention, this is prevented because the edge prevents the suspending means from being operated when the binder is closed (in both the first and third position).

Similarly, none of the other cited references discloses a suspension element that opens and closes a binder ring as it moves between three positions, as defined in amended Claim 4. Accordingly, it is respectfully submitted that amended Claim 4 patentably distinguishes over the prior art.

#### Amended Claim 5

Applicants have also amended Claim 5 to define suspension elements that interfere with at least one of the front cover, the back cover and the spine during pivoting of the covers, thereby

preventing the storage device from pivoting to the closed condition. It is respectfully submitted that none of the cited references, taken alone or combined, disclose a suspension element that interferes with closure of the storage device when the suspension element is in a third position, as defined in amended Claim 5.

In the claimed invention, the front and rear covers serve to protect the papers inside the storage device, once closed, but also have a function in combination with the suspending elements. Indeed, in the middle position the covers can not be closed against each other, because the suspending elements prevent this. Only when the suspending elements are fully extended or retracted (to the first or second position) the covers can be closed, preventing opening of the rings. None of the cited prior art references discloses or even suggests such combination effect.

In Schudy the suspension elements only lock the rings in the extended situation. If this binder is therefore used for traveling, either the suspension means extend beyond the boundary of the binder covers (and will thus be a nuisance), or they will not lock the ring, which could result in unintended opening of the rings and thus dislodging the papers (which will fall all over the place because there is no closing edge either).

Thus, none of the cited references discloses a suspension element that interferes with closure of the storage device when the suspension element is in a third position, as defined in amended Claim 5. Accordingly, it is respectfully submitted that amended Claim 5 patentably distinguishes over the prior art.

Application Serial No.: 10/587,555  
Reply to Office Action of April 14, 2008  
Amendment Dated: October 14, 2008

### Conclusion

In view of the foregoing amendment and remarks, favorable consideration and allowance of the application with Claims 1-11 are respectfully solicited. If the Examiner believes that a telephone interview would assist in moving the application toward allowance, he is respectfully invited to contact the Applicant's attorney at the telephone number listed below.

Respectfully submitted,



---

Steven T. Zuschlag  
Registration No.: 43,309  
Attorney for Applicants

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(516) 822-3550  
STZ/mf

303167\_1.DOC